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Dated: February 23, 2010

Signature:


(Lisa de Cordova)

Docket No.: 65003/P002US/10312242
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ajay R. Bam et al.

Application No.: 10/691,459

Confirmation No.: 7339

Filed: October 22, 2003

Art Unit: 3688

For: SYSTEM AND METHOD OF GENERATING,
DISTRIBUTING, AND/OR REDEEMING
PROMOTIONAL OFFERS USING
ELECTRONIC DEVICES

Examiner: K. H. Le

APPELLANT'S REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer mailed December 23, 2009 and is in furtherance of the Notice of Appeal, dated August 31, 2009 and received by the United States Patent Office on August 31, 2009, and Appellant's Brief, dated October 31, 2009 and received by the United States Patent Office on October 31, 2009.

As required under 37 C.F.R. § 41.41(a), this Reply Brief is filed within two months after the Examiner's Answer dated December 23, 2009, and is in furtherance of the Appeal Brief filed October 31, 2009.

No fee is required for this Reply Brief.

This Reply Brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to Be Reviewed on Appeal
- III. Remarks
- IV. Conclusion

I. Status of Claims

The status of claims remains as identified in the Appeal Brief submitted October 31, 2009, wherein claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 stand rejected and are presented for appeal.

II. Grounds of Rejection to be Reviewed on Appeal

The Examiner has withdrawn the rejection of claims 66-69 under 35 U.S.C. § 101. Thus, the ground of rejection remaining is whether claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 are properly rejected under 35 U.S.C. § 103 as being unpatentable over *Narasimhan* in view of Official Notice and/or legal precedent.

III. Remarks

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Narasimhan* in view of Official Notice and/or legal precedent. On October 31, 2009, Applicant filed an Appeal Brief explaining why these claims are not obvious in view of the asserted combination of *Narasimhan* in view of Official Notice and/or legal precedent. In the Appeal Brief, Applicant argued many of the rejected claims separately, and thus respectfully asserted that the separately argued claims do not stand or fall together. *See* 37 C.F.R. § 41.37(c)(1)(vii). Applicant hereby incorporates and reasserts the arguments presented in the Appeal Brief but, for brevity, does not repeat all the arguments herein. Rather, Applicant provides limited remarks in response to issues contained in the Examiner's Answer. The organization of the arguments is not intended to, and in no way does, constitute a waiver of Applicant's election to argue claims separately. Thus, Applicant respectfully requests that the Board reverse the rejections in light of Applicant's prior remarks as well as the additional remarks contained herein.

A. No Official Notice Taken by Examiner Myhre

Applicant maintains that Examiner Myhre did not take Official Notice with respect to the rejections of Applicant's claims. As Applicant stated in the Appeal Brief dated October 31, 2009, Examiner Myhre never made statements such as "it is known before invention time" in rejecting Applicant's claims and he never relied on any references other than

Narasimhan in making his rejections. *See, e.g.*, Appeal Brief at 15. The Examiner, for the first time in the Examiner's Answer, implicitly acknowledges that Applicant is correct and now alleges that her own statements in the Office Action of October 15, 2008 constitute Official Notice. Applicant does not assert that the present Examiner cannot rely on Official Notice but merely seeks acknowledgment that there was no Official Notice taken by Examiner Myhre and thus the present Examiner improperly contended that rejections made by Examiner Myhre were in any way based on Official Notice. Accordingly, any rejections relying on Examiner Myhre's alleged Official Notice are in error and should be withdrawn.

B. The Alleged Official Notice and Legal Precedent Relied Upon by the Present Examiner Are Insufficient to Establish Obviousness

The rejections of record rely on *Narasimhan* as allegedly teaching the limitations of Applicant's claims. Applicant has previously demonstrated how the smart card of *Narasimhan* is clearly not a mobile electronic device and cannot be used to perform the limitations of Applicant's claims. In fact, the Examiner acknowledges that if the smart card of *Narasimhan* is not a wireless device, then wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in *Narasimhan*. Accordingly, Applicant respectfully asserts that the rejections of record based on *Narasimhan* should be withdrawn. In order to attempt to address the myriad shortcomings of *Narasimhan* as an applied reference, the Examiner elects to rely on Official Notice and/or legal precedent. However, the references cited in support of the alleged Official Notice such as *Aggarwal*, *Kolls* and *Freeman* fail to meet the "substantial evidence" standard and more particularly, the Examiner fails to show how any of these references constituting alleged Official Notice could be incorporated into *Narasimhan*. Accordingly, the rejections of record should be withdrawn.

While the Examiner relies on these "Official Notice" references to allege that various user devices or terminals can all be used interchangeably to receive/transfer data, the Examiner fails to provide any rationale as to how a cellular device could be substituted for the smart card of *Narasimhan* into the system of *Narasimhan* that is alleged to meet the limitations of Applicant's claims. *See* Examiner's Answer at 24-25. The Examiner relies on *Aggarwal* to allege that it would have been obvious to replace the smart card of *Narasimhan* with a wireless device such as a cellular phone, if desired, at least, since the cellular phone is

an alternative among a known few, as taught by *Aggarwal*. *Id.* The Examiner stops short of providing any explanation as to how a cellular phone, such as that allegedly disclosed in *Aggarwal*, may be substituted for the *Narasimhan* smart card and then incorporated **into the system of *Narasimhan***. Rather, Applicant asserts that the alleged combination advanced by the Examiner would change the principle of operation of *Narasimhan*. See M.P.E.P. § 2143.01. As previously discussed (*see, e.g.*, Appeal Brief at 14), the user of the smart card in *Narasimhan* utilizes a smart card reader/writer to store coupons in a database on the smart card. See, *e.g.*, column 7, lines 23-27. As such, the smart card in *Narasimhan* is meant to act as an **interface** with the smart card reader/writer and/or the user's personal computer, and the Examiner has not provided any rationale as to why or how a cellular phone, for example, could be substituted into the system of *Narasimhan* for the smart card in order to allegedly teach the limitations of Applicant's claims.

Further, Applicant respectfully disagrees with the Examiner's assertions regarding the *Kolls* reference. The Examiner states that the portion of *Kolls* cited by Applicant only discusses possible system configurations and does not detract from *Kolls* as support for Official Notice. See Examiner's Answer at 26. Applicant respectfully disagrees. The Examiner's response fails to address the substance of Applicant's argument – that there is no teaching in *Kolls* of a smart card and a smart card reader/writer being interchangeable with a wireless device or any teaching of wirelessly transmitting data to such a combination or applying a promotion using such a combination. Thus, Applicant respectfully requests that the rejections of record with respect to Official Notice be withdrawn.

The Examiner also fails to address Applicant's prior statements regarding the teachings of *Freeman*. While the Examiner claims that the chip card of *Freeman* allegedly can transmit and receive data wirelessly (*see* Examiner's Answer at 26), the disclosure of *Freeman* merely discusses wireless means in the context of recognition of a chip within a vehicle on a toll road. See, *e.g.*, column 12, lines 13-15. There is simply no disclosure of wireless transmission of data to the chip card in *Freeman* or wirelessly applying a promotion to a purchase using the chip card of *Freeman* as recited, for example, in independent claim 1. Moreover, *Freeman* fails to evidence the state of the art allegedly teaching wirelessly transmitting data relating to a promotion to a mobile electronic device or wirelessly applying a promotion to a purchase using a mobile electronic device.

With respect to the Examiner's legal precedent argument based on *Leap Frog*, Applicant maintains that the Examiner has not demonstrated how the smart card of *Narasimhan* could allegedly be updated with "modern components" or how the "modern components" allegedly teach what is claimed by Applicant. There is simply no teaching set forth in the "Official Notice" references for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." The Examiner argues that "wireless transfer of data teaching and suggestion is in the Official Notice." See Examiner's Answer at 26. Applicant respectfully disagrees insofar as the Examiner fails to provide any evidence how a cellular phone or other mobile electronic device could be properly incorporated into the system of *Narasimhan*. Even if *Aggarwal* teaches interchangeability of a smart card with other wireless devices as the Examiner suggests (*see id.*), the rejection is improper again as the Examiner has not addressed how a cellular phone or other mobile electronic device could be incorporated into *Narasimhan*. Accordingly, Applicant respectfully requests that the rejections of record be withdrawn.

C. The Obviousness Rejections Should be Withdrawn

1. The Newly Applied Rejections Fail to Set Forth a *Prima Facie* Case of Obviousness

Applicant notes that many of the rejections in the Examiner's Answer differ from the rejections that Applicant previously responded to in the Appeal Brief. For example, with respect to dependent claim 16, the Examiner alleges that Applicant argues *Narasimhan* as if the rejection was based on anticipation and the Examiner alleges that *Aggarwal* "clearly shows downloading promotions to e.g. wireless cell phones." See Examiner's Answer at 27. However, a review of the Examiner's rejection forming the basis of this appeal demonstrates that the Examiner did not rely on *Aggarwal* as allegedly teaching this limitation of claim 16 until the Examiner's Answer. Rather, the rejection was previously based on an allegation that *Narasimhan* teaches claim 16. See, e.g., Examiner's Answer at 19. In any event, the Examiner fails to provide any support for the assertion that *Aggarwal* allegedly teaches this limitation of claim 16. Moreover, the Examiner also fails to demonstrate how the alleged teachings of *Aggarwal* can properly be incorporated into the system of *Narasimhan* to teach this limitation of claim 16. Accordingly, Applicant respectfully requests that the rejection of record be withdrawn.

Similarly, with respect to dependent claim 63, the Examiner now appears to rely on the combination of *Narasimhan* and *Aggarwal* in making the rejection when the rejection on which this appeal was originally based alleged that *Narasimhan* taught this limitation of claim 63. *See* Examiner's Answer at 20. Accordingly, the Examiner has changed the rejection as Applicant sufficiently refuted the rejection that was originally on appeal. In any event, the new rejection also should be withdrawn given that the Examiner merely cites to language of a prior Office Action as allegedly demonstrating what *Narasimhan* discloses but fails to identify any portion of *Narasimhan* itself that makes such a disclosure. Rather, the smart card of *Narasimhan* does not send communications for the system to respond to for coordinating payment for an associated transaction, and instead acts as a traditional credit or debit card for payment purposes. Thus, this limitation of claim 63 is not taught by the rejection of record.

2. Other Rejections Lack Adequate Support to Justify a Finding of Obviousness

Other rejections made by the Examiner fail to find adequate support in the Examiner's Answer. Again, the Examiner alleges that Applicant has argued *Narasimhan* as if the rejections were based on anticipation. *See, e.g.*, Examiner's Answer at 26. This is incorrect. Rather, Applicant's arguments were based on the scope of the rejections that had been applied. For example, with respect to dependent claim 3, a review of the prior Office Actions as well as the Examiner's Answer demonstrates that the Examiner did not rely on Official Notice in making the rejection. Further, the Examiner fails to address Applicant's arguments concerning how *Narasimhan* fails to teach this limitation, and the Examiner's Answer still fails to address how the Official Notice allegedly teaches this limitation, particularly with respect to how the teachings of the "Official Notice" references may be incorporated into the system of *Narasimhan* without changing the principle of operation of the system. This same pattern is shown with respect to the Examiner's alleged arguments concerning at least claims 7, 8, 13-14, 16-21, 33, 35, 37, and 58.

For example, the Examiner states that "[w]ireless applying said promotion using said mobile electronic device' is clearly taught by *Aggarwal*." *See* Examiner's Answer at 26. However, the Examiner fails to provide any support for this assertion. Moreover, even if the Examiner alleges that the "wireless transfer of data teaching and suggestion is in the Official

Notice with e.g. Aggarwal as support,” Applicant has previously discussed how the Examiner has not discharged her burden to show how the references providing alleged support for the Official Notice could be incorporated into the system of *Narasimhan*. In the absence of such explanation, the rejection of record should be withdrawn.

With respect to independent claim 22, the Examiner alleges that *Narasimhan* teaches a database of coupons stored on the smart card accessible for redemption at POS's. See Examiner's Answer at 27. However, as previously noted by Applicant, the coupons of *Narasimhan* are not sent to a consumer web portal account wirelessly accessible on a mobile electronic device. See Appeal Brief at 22. Rather, the Examiner elects to argue that downloading from an internet server allegedly reads on “sending promotion data to a consumer web portal accessible to a consumer” effectively omitting the relevant claim language that the consumer web portal account is “**wirelessly accessible on a mobile electronic device** of said consumer.” Assuming *arguendo* that there is a consumer web portal account and a mobile electronic device in *Narasimhan* (which Applicant asserts that neither is shown in *Narasimhan*), that account is not wirelessly accessible on the smart card of *Narasimhan*. Rather, the smart card must be physically associated with a smart card reader/writer in order for promotion data to be stored on or retrieved from the smart card. Thus, the account is not wirelessly accessible on a mobile electronic device. The Examiner then attempts to combine the teachings of *Narasimhan* with *Aggarwal*. See Examiner's Answer at 27-29. However, the Examiner fails to demonstrate how the cellular phone of *Aggarwal* may properly be introduced into the system of *Narasimhan* without changing the principle of operation of the *Narasimhan* system. Accordingly, the Examiner has not met her burden to show *prima facie* obviousness, and thus, the rejection should be withdrawn.

Further, with respect to the Examiner's arguments concerning independent claims 26, 30, 37, 55, 61 and related dependent claims as well as dependent claims 33 and 35 (see Examiner's Answer at 29-30), the Examiner fails to discharge her burden of proving that the substitution of the *Aggarwal* cell phone for the combination of PC and smart card is clearly within the level of skill in the art. The Examiner relies on the assertion that these consumer devices are just “information appliances” which can all have “.. a display device and an input device, and optionally storage and printing devices.” See Examiner's Answer at 29. However, as Applicant has previously discussed, the smart card of *Narasimhan* does not

contain these alleged components of a consumer device. For example, the smart card of *Narasimhan* does not have input or output means; rather, data is placed onto the smart card via a smart card reader/writer. *See, e.g.*, column 7, lines 23-27. Thus, the Examiner cannot demonstrate that such interchangeability exists between the smart card disclosed in *Narasimhan* and other consumer devices, such as those disclosed in *Aggarwal*. Accordingly, the rejections of record should be withdrawn.

D. The Examiner Fails to Acknowledge Applicant's Arguments With Respect to Independent Claims 41 and 49 and Their Respective Dependent Claims as well as Dependent Claim 21

Finally, Applicant notes that the Examiner has failed to address independent claims 41 and 49 and their respective dependent claims in the Examiner's Answer. The Examiner addresses independent claims 26, 30, 37, 55 and 61 on pages 29-30 of the Examiner's Answer but any acknowledgement of Applicant's arguments with respect to independent claims 41 and 49 and their respective dependent claims is conspicuously absent. Applicant maintains that the claims are allowable at least for the reasons set forth in pages 40-43 of the Appeal Brief mailed October 31, 2009. Further, Applicant presented arguments concerning the patentability of dependent claim 21 on page 22 of Applicant's Appeal Brief. However, the Examiner failed to acknowledge or respond to Applicant's arguments with respect to this claim. Therefore, Applicant respectfully requests that the rejection of record be withdrawn.

IV. Conclusion

Applicant believes that each of the pending claims is in condition for allowance and respectfully requests that the rejections of record be overturned. Please charge any additional fees required or credit any overpayment during the pendency of this Application pursuant to

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37 C.F.R. §§ 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 65003/P002US/10312242 from which the undersigned is authorized to draw.

Dated: February 23, 2010

Respectfully submitted,

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